

Remarks

Claims 1-4, 6-21, 23-33, 35-39, 42-44 and 47-51 are pending in the application. Applicants previously amended claims 1, 30, 42, 44, 47 and 49 in an attempt to overcome an indefiniteness rejection. According to the Advisory action, these amendments added new matter. While Applicants disagree, for the purpose of expediting prosecution these claims have been amended back to their original form. Claims 8, 9, 43 and 47 have been rejected for indefiniteness for the use of the terms “comprises” and “does not comprise”. These claims have been amended to replace “comprises” with “is” and “does not comprise” with “is not”. New claims 57-62 have been added to specify that the cation is monovalent or divalent. Support for this amendment is found in the specification at page 15, lines 21-22. All claims have been found to be allowable over the prior art.

The rejection of claims 1, 30, 42, 44, 47 and 49 for indefiniteness is respectfully traversed. The inventors provide small molecule inhibitors of histone deacetylases. The compounds according to the rejected claims all have a single ionizable moiety, designated as M. M is defined as hydrogen or a pharmaceutically acceptable cation. This is because these compounds can be provided as a free acid or its salt. The rejection is based on the valency of the cation being undefined. Applicants respectfully submit that the valency of the cation is utterly irrelevant to the invention. Any valency will work. To require a specified valency would allow an infringer to infringe with impunity merely by using a different cation, which would have no effect on the activity of the small molecule, and thus would deprive the inventors of any meaningful protection of their invention.

The definiteness requirement arises from 35 U.S.C. §112, 2d ¶, which states that “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter *which the applicant regards as his invention*. (emphasis added) Its purpose is to allow one skilled in the art to ascertain whether he or she is infringing the claim. Applicants do not regard as their invention a “pharmaceutically acceptable cation” as their invention. Such cations have been well known for decades. One skilled in the art would clearly ascertain that if he or she is

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making, using, selling or importing the small molecule inhibitors of the rejected claims, he or she is infringing the claims *regardless of the valence of the cation*. Accordingly, Applicants submit that claims 1, 30, 42, 44, 47 and 49 satisfy both the letter and the purpose of the statute. Thus, this rejection should be withdrawn.

A Notice of Appeal accompanies this communication. If the Examiner believes that any discussion of this communication would be helpful, he is invited to call the undersigned attorney at 781-933-6630.

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Respectfully submitted,

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